

Remarks

Claim Rejections - 35 U.S.C. § 103(a)

Claims 10-17, 27-34, 38-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marshall et al. (U.S. 2005/0208995). Of the rejected claims, claims 10, 27, 44, and 50 are independent claims.

By way of example, Independent claim 10 recites that the graphical user interface screen includes a “first set of a plurality of selectable graphical identifiers each associated with a respective entrants in said first race” whereby the request from the user to display the reconfigured table is received. Independent claim 10 also recites that the graphical user interface screen includes a “second set of a plurality of selectable graphical identifiers each associated with a respective combination of entrants for said exotic wager type.” Selection of an individual selectable graphical identifier from the second set of selectable graphical identifiers initiates placement of a wager on the respective combination of entrants associated with the selected individual selectable graphical identifier. Independent claim 10 also recites that “said first and second sets are displayed together in said graphical user interface screen for selection by said user.” As set forth in amended claim 10, the user can cause the display of probable payout information for different combinations of entrants and without switching graphical user interface screens, the user can select a single (i.e., individual) identifier associated with a desired combination of entrants to initiate a wager on the selected combination of entrants.

The improved efficiency of the method is of particular benefit to skilled wagerers who need to be able to find and analyze probable payout information quickly. These skilled wagerers often wait until the wagering period draws to a close (i.e., when the probable payouts are most accurate) to place their wagers. The combination of (a) allowing initiation of a wager on a

combination of entrants by selecting an individual selectable graphical identifier associated with the selected combination from a number of different identifiers (associated with different combinations) (as recited in claim 10 prior to amendment) with (b) displaying the first and second sets of graphical identifiers together for selection by the user in the same graphical user interface screen (as recited in currently amended claim 10) provides the skilled wagerer with a powerful tool for obtaining payout information on exotic wager types and for quickly and easily (i.e., with a single selection associated with a desired combination) initiating a wager on the selected combination of entrants all without the need to navigate to another graphical user interface screen.

Marshall does not teach this combination of features. FIGS. 58-60 illustrate Marshall's methods of displaying payout information for the exacta wager and of placing a wager. The probable payout information is displayed in a payout window 5810 in response to the selection 5805 (FIG. 58). Initiation of the wager is made through the "Exacta Will Pay" tab of the interface. In order to initiate placement of an exacta wager on, for example, a 3/13 combination, the user first selects an indicator associated with the first entrant (as shown by the highlight of "3 Ashore" in FIG. 59) and then selects an indicator associated with the second horse (as shown by the bolded outline of "13 My Guy Jase" in FIG. 59). (Par. 114). Selection of this combination of indicators then causes display of the interface of FIG. 60, from which the user can select a bet on the selected entrants (e.g., boxed, 3-13, 13-3).

The method as illustrated in FIGS. 58-60 does not allow initiation of a wager on a combination of entrants by selecting an individual selectable graphical identifier from the second set of identifiers where first and second sets of graphical identifiers together for selection by the user in the same graphical user interface screen. As discussed above, multiple selections must be

made to select a combination of horses on which to wager See FIGS. 58-59. Therefore, FIGS. 58-59 do not teach the recited second set of graphical identifiers. In addition, the purported "selectable identifiers" (previously asserted as such by the Examiner) in window 6002 of FIG. 60 are not displayed together for selection by the user with the purported first set of graphical identifiers (previously identified by the Examiner with regard to FIGS. 58-59).

The Office Action of May 31, 2007 admits that "Marshall excludes the selectable identifiers associated with respective entrants and the selectable identifiers associated with respective combinations of entrants displayed together within the same graphical interface screen for selection by said user." Office Action at page 3. The Office Action then states:

However, Applicant discloses that having to navigate through various screens causes a problem wherein a player has to remember important information and furthermore that too much information on one screen can be prove to be overwhelming. These are advantages that are well known in the art and are common reasons for an artisan skilled in the art to manipulate or alter a GUI and information within an GUI for making it a more user-friendly system.

Furthermore, when referring to FIG. 60 of Marshall, the payouts of an appealing wager and the selectable combinations are displayed at once. One of art-skilled in the art, furthermore, whether an expected Marshall's GUI, an Applicants invention, to perform equally well with either the selectable entrants for displaying payouts and the selectable combinations for placing wagers displayed individually, as taught by Marshall, or the claimed in one screen because both would perform the same function of providing a means for requesting payout information and selecting entrants' combinations.

Therefore, it would have been *prima facie* obvious to modify Marshall to obtain the invention as claimed because such a modification would have been considered a near design consideration which fails to patentably distinguish over the prior art of Marshall.

This same obviousness rejection is applied to each of the independent claims 10, 27, 44, and 50 and is, therefore, used as the principal basis for the rejection of all pending claims. For the

reasons that follow, Applicants respectfully traverse the rejections of all claims and respectfully request reconsideration and allowance of the claims.

First, pursuant to MPEP § 2144.03 the rejections should be withdrawn because the Office Action improperly relies on alleged common knowledge as a principal basis of rejection without evidentiary support. As stated in MPEP § 2144.03:

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697.

Accordingly, Applicants respectfully submit that it is improper for the Office Action to assert that the advantages of Applicants' invention are commonly known in the art without citing evidentiary support as required by MPEP § 2144.03. The requirements of MPEP § 2144.03 are particularly applicable here because the Office Action's conclusion as to "common" knowledge contradicts Marshall et al. – the only reference cited by the Office Action. More specifically, as admitted by the Office Action, Marshall et al. shows that the prior art excludes the selectable identifiers associated with respective entrants and the selectable identifiers associated with respective combinations of entrants being displayed together within the same GUI screen for

selection by said user. The fact that Marshall et al. teaches away from Applicants' invention must be considered. See MPEP § 2141.02. Thus, it is respectfully submitted that the rejection of all pending claims should be withdrawn not only because such is improper under MPEP § 2144.03 but also because the conclusion of "common" knowledge contradicts the express indications of reference Marshall et al. cited in the Office Action.

Second, Applicants respectfully submit that the rejection of all pending claims should be withdrawn because the Office Action's proposed modification would change the basic principle of operation of Marshall et al. As set forth in MPEP § 2143.01, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." As admitted in the Office Action, Marshall et al. excludes the selectable identifiers associated with respective entrants and the selectable identifiers associated with respective combinations of entrants being displayed together within the same GUI screen for selection by said user. Improperly using the hindsight of Applicants' disclosure to modify Marshall et al. such that "said first and second sets are displayed together in said graphical user interface screen for selection by said user" would change the operation of Marshall et al. as prohibited by MPEP § 2143.01. Thus, for this reason as well, Applicants respectfully submit that the rejections of all pending claims should be withdrawn.

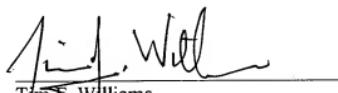
Favorable reconsideration and allowance of the present application is respectfully requested. Applicants hereby petition for an extension of time required to make this response timely, and therefore, have included the required fees in connection with this Response. However, if any additional fee or extension of time is required to obtain the entry of this

response, the undersigned hereby petitions the Commissioner to grant any necessary time and extension and authorize its charging deposit account no. 04-1403 for any such fee not submitted herewith.

Respectfully requested,

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Dated: _____



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